



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/524,619      | 11/10/2005  | Stephen Jane         | DAVI251.001APC      | 1433             |

20995 7590 11/20/2007  
KNOBBE MARTENS OLSON & BEAR LLP  
2040 MAIN STREET  
FOURTEENTH FLOOR  
IRVINE, CA 92614

|          |
|----------|
| EXAMINER |
|----------|

JOIKE, MICHELE K

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1636

|                   |               |
|-------------------|---------------|
| NOTIFICATION DATE | DELIVERY MODE |
|-------------------|---------------|

11/20/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
eOAPilot@kmob.com

## Office Action Summary

Application No.

10/524,619

Applicant(s)

JANE ET AL.

Examiner

Michele K. Joike, Ph.D.

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 12 and 16 is/are pending in the application.
- 4a) Of the above claim(s) 7, 12 and 16 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-6 is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Receipt is acknowledged of a reply to the previous Office Action, filed August 27, 2007. Claims 1-7, 12 and 16 are pending, with claims 1-6 examined. Claims 7, 12 and 16 are withdrawn. Any rejection of record in the previous Office Action, mailed April 13, 2007, that is not addressed in this action has been withdrawn.

Because this Office Action sets forth new rejections that are not necessitated by amendment, this Office Action is made NON-FINAL.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 and newly added claim 3 are rejected under 35 U.S.C. 102(b) as being anticipated by BM460207 (1999).

Note: The claims are drawn to nucleic acids encoding or complementary to a sequence encoding a mammalian transcription factor (defined in the specification as "a homolog of *Drosophila grh*, i.e. M-GRH" --see page 5, lines 3-4) comprising nucleotide sequences capable of hybridizing to SEQ ID NO: 7, SEQ ID NO: 15 or a fully complementary sequence of any of the foregoing under conditions of (0.1X SSC, 0.1% w/v SDS at 65°C. Since there are no wash conditions listed, and there is no indication that these conditions are highly stringent, the Examiner has interpreted a

Art Unit: 1636

“complementary sequence” to include any level of complementarity. The claims thus encompass any nucleic acid sequence that is complementary to a sequence encoding an M-GHR homolog comprising human or murine SOM-encoding sequences.

Furthermore, because the specification has defined complementary as “the capacity for precise pairing between two nucleobases of an oligomeric compound” (see page 59, lines 25-26), the claims encompass any nucleic acid sequence comprising at least two “nucleobases” which can precisely pair with any sequence present in a nucleic acid which encodes a mammalian transcription factor. Because two nucleotides complementary to, e.g., a sequence encoding SEQ ID NO: 8 (e.g. SEQ ID NO: 7) would represent not even a single percent of identity (2/1870 nucleotides would be 0.1% identity), the claims encompass nucleotide sequences with as little as 0.1% identity to, e.g., SEQ ID NO: 7. Similar reasoning is applied to claim 3. Since the language of claim 3 is not Markush language, but a nucleic acid sequence encoding a polypeptide comprising an amino acid sequence of SEQ ID NO: 8 or 16, then a dipeptide reads on SEQ ID NO: 8 or 16.

The sequence disclosed as GenBank Accession No. BM260207 comprises a nucleic acid sequence which is 26.2% identical to SEQ ID NO: 7 as indicated by the alignment provided for Applicant as “Exhibit B.” Exhibit 1 (submitted by Applicant) shows a 163 amino acid long alignment between SEQ ID NO: 8 and BM46027. Therefore, BM260207 anticipates claims 1, 2 and 3.

**Response to Arguments Concerning Claim Rejections – 35 USC § 102 (b)**

Applicants' arguments filed on August 27, 2007 have been fully considered. The following grounds of traversal are presented:

Applicants argue that BM460207 is an EST sequence that when translated only encodes a 163 amino acid long region that aligns with SEQ ID NO: 8. Therefore, BM460207 has at most 26.8% identity to SEQ ID NO: 8, and not the 95% identity required by claim 1.

Applicants' arguments are not found persuasive for the following reasons.

As discussed above, Applicants are claiming an amino acid sequence, as opposed to the amino acid sequence, having at least 95% identity to SEQ ID NO: 8. The 163 amino acid region of BM460207 has at least 95% identity to SEQ ID NO: 8.

***Allowable Subject Matter***

Claims 4-6 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele K. Joike, Ph.D. whose telephone number is 571-272-5915. The examiner can normally be reached on M-F, 9:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach can be reached on 571-272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1636

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michele K Joike, Ph.D.  
Examiner  
Art Unit 1636

  
DAVID GUZO  
PRIMARY EXAMINER